

REMARKS

Claims 2-3 and 9-12 have been amended to further patentably distinguish the invention from the prior art and correct a minor informality. Claims 1, 4-8 and 13-20 remain canceled. Such amendments of claims are only for the purpose of expediting the prosecution of this application and are not to be construed as an abandonment of any of the novel concepts disclosed therein.

The Office Action States:

Claims 2, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lasky US Patent 6367078. Regarding claim 9, Lasky teaches a method comprising enabling a user of a control device to indicate a value of a possible new preset of a sound signal source by inputting a channel selection (col. 1 lines 55-58). Lasky teaches while the new values has been indicated but before the indication has been conifl-med to change an operation of another device such as the video display generator which overlays the a graphical representation of the channel number on the video of the selected channel (col. 1 lines 60-65). Lasky teaches the newly channel selection is presented to the video display generator for a few seconds to allow the viewer to confirm the selection (col. 1 line 65-col. 2 line 2).

Regarding claim 2, Lasky teaches the preset is a channel number provided by a television distribution network (col. 1 lines 55-58) and channel number of a television distribution network inherently includes a sound source.

Regarding claim 10, Lasky teaches inputting a channel selection (col. 1 lines 55-58) and the examiner considers the channel number as the identifier of a station P.p. 2-3.

This ground of rejection is respectfully traversed.

In KSR Int'l Co. v. Teleflex Inc., 82 U.S.P.Q. 2d 1385, 1396 (U.S. 2007), after stating the steps "in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent in issue", the Court said, "To facilitate review this analysis should be made explicit." See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obvious grounds cannot be sustained by mere conclusory statements, instead

there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

“A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S., at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight”)(quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 [141 USPQ 549] (CA6 1964))). *Id.* 1397.

In *Ex parte Aylward*, (BPA&I, Appeal No. 2007-2368 December 4, 2007) the Board said in reversing a final rejection,

“Both anticipation under §102 and obviousness under §103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . The second step in the analysis requires a comparison of the properly constructed claims to the prior art”. *Medichem, S.A. v. Rolabo, SL.*, 353 F. 3d 928, 933 (Fed. Cir. 2003) (internal citations omitted):

A. CLAIM CONSTRUCTION

“The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art.” *In re Lowry* 32 F. 3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F. 2d. 1381, 1385 (Fed. Cir. 1983). Slip Op. Pp. 7-8.

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“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness.” *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *in re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). “A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell*, 991 F.2d 781,783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F. 2d 1048, 1051 (CCPA 1976)).

In *Ex parte Hamilton* (BPA&I Appeal No. 2007-3091, March 11, 2008) in reversing a final rejection the Board said:

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591

(Fed. Cir. 1991), and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Slip Op. Pp. 5-6.

The pertinence of the specification to claim construction is reinforced by the manner in which a patent is issued. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). *Phillips v. AWH Corp.*, 76 U.S.P.Q. 1321, 1329 (Fed. Cir. 2005) (en banc).

The claim language must be interpreted in light of the specification as it would be interpreted by one of ordinary skill in the art. The application is entitled REMOTE CONTROLLING. FIG. 2 of the application, reproduced on the cover page of the published application, shows remote control unit 50 with display 62 that furnishes the indications to the user of the, remote control 50, an indication of the value representative of a current preset associated with a sound signal source separated from the control unit, the current preset having been preselected by the user as being of interest and simultaneously providing an indication of a value of a possible new preset associated with the sound signal source and providing the user an edit option and auditory feedback corresponding to the new value. ¶ 43.

In explaining the display shown in FIG. 4B, the specification describes the claimed limitations in ¶¶ 41-42 as, "While a station is highlighted, the user may enter (and may change) a new value 126 for the preset. Both the current preset 124 and the new value 126 are shown on display [62] at the same time. To enter a new value for the highlighted preset, the user presses the center button 58 up or down to tune up or down, or the user can press the back button 68 and the forward button 70 to seek back or forward respectively.

* * *

Having the current preset value 124 and the new preset value 126 visible on display [62] at the same time makes it easier for the user to be certain that the change that will be effected is

the one he wishes and allows him to retain the current setting easily if he chooses not to change it.”

“It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention.” *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

“Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

“This court has repeatedly stated that the defense of lack of novelty (i.e., ‘anticipation’) can only be established by a single prior art reference which discloses each and every element of the claimed invention.” *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, “Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim,” 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term “engaging the ball” recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages

the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

The portions of the reference cited by the Examiner read as follows:

The viewer can enter a channel number on a numeric keypad of the remote control and a receiver **124** will forward the number to a contr4oller **125**. In a simple system, the controller accepts the two numbers. Col.1, lines 55-58

The controller causes tuner **121** to pass a video signal **131** of the selected channel to a video-display generator **122**. The video-display generator also receives the selected channel number directly from the controller and overlays a graphical representation of the channel number **132** on the video of the selected channel Col. 1 lines, 60-65

Typically the controller presents a newly selected channel number to the video-display generator only for a few seconds, to allow the viewer to confirm the selection that he or she made. Col. 1, line 65-col.2, line 2

The reference fails to disclose the claimed steps involving a remote control unit with a display. It is therefore impossible to meet the limitations in the amended claims calling for a method comprising enabling a user of a remote control unit for controlling a sound signal source separated from the remote control unit to indicate a value displayed on the remote control unit of a possible new preset of a sound signal source and to separately confirm the indication

and, while the new value has been indicated, but before the indication has been confirmed, to change an operation of another device separated from the remote control unit in accordance with the indicated possible new value while providing auditory feedback to the user corresponding to the new value. Accordingly, it is impossible to read the limitations in the rejected claims on the reference, and withdrawal of the rejection of claims 2, 9 and 10 as anticipated by the reference is respectfully requested. If this ground of rejection is repeated the Examiner is respectfully requested to quote *verbatim* the language in the reference regarded as corresponding to each limitation in at least claim 9.

The Office Action states:

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lasky US Patent 6367078 in view of Sgambati et al. US Patent Application Publication 20020057207.

Regarding claim 3, Lasky is not explicit in teaching the multi-media system comprises an audio system. Sgambati et al. in an analogous art teaches a multimedia system comprising an audio system (paragraph 019).

It would have been obvious to one of ordinary skill in the art to have an audio system in the multi-media system of Lasky because the system of Lasky represents a home entertainment system and a home entertainment system conventionally includes an audio system in order to provide various sources of entertainment to the users. **P.p. 3-4**

This ground of rejection is respectfully traversed.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

This claim is dependent upon and includes all the limitations of claim 9, and we have shown above that the primary reference fails to anticipate the limitations of claim 9. It is therefore impossible to combine the references to meet the limitations of claim 3. Accordingly

withdrawal of the rejection of claim 3 as unpatentable over the primary and secondary references is respectfully requested. If this ground of rejection is repeated the Examiner is respectfully requested to quote *verbatim* the language in the references regarded as corresponding to each limitation in claim 3.

The Office Actions states:

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lasky US Patent 6367078 in view of Sass et al. US Patent 6769028.

Regarding claims 11-12, Lasky is silent on teaching the station comprises a radio station and the other device comprises a radio receiver. Sass et al. in an analogous art teaches selecting a radio station and teaches a radio receiver (col. 5 lines 9-15, col. 11 lines 42-45). Lasky also teaches the sound signal source comprises a source of items to be performed (pre-roll messages), the source being configured to store the items for performance in response to the preset (col. 11 lines 42-45).

It would have been obvious to one of ordinary skill in the art to modify the system of Lasky as disclosed by Sass et al. because the system of Lasky represents a home entertainment system and a home entertainment system generally include a radio receiver and a means for selecting a radio station channel P.4.

This ground of rejection is respectfully traversed. Claims 11 and 12 are dependent upon and include all the limitations of claim 9. We have shown above the primary reference fails to anticipate claim 9. It is therefore impossible to combine the references to meet the limitations of claims 11 and 12. Accordingly withdrawal of the rejection of these claims is respectfully requested. If this ground of this rejection is repeated, The Examiner is respectfully requested to quote verbatim the language in each reference regarded as corresponding to the limitations in claims 11 and 12.

The courtesy of the Examiner in conducting an additional diligent search is acknowledged with appreciation. At least as amended the claims are clear of the prior art.

“The days of an adversarial relationship with patent applicants are over,” Patent and Trademark Office Director David J. Kappos Nov. 19 told an audience of academics, practitioners and a few of his employees. In his first few months in office, Kappos said that [he] has repeatedly instructed Examiners to help applicants find patentable subject matter.” 79 PTCJ 101 (November 27, 2009).

While we submit the claims properly define patentable subject matter, we are receptive to help from the Examiner in defining patentable subject matter in this application.

In view of the foregoing amendments, authorities, remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in condition for allowance, and notice thereof is respectfully requested. If the Examiner believes the application is not in a condition for allowance, he is respectfully requested to telephone the undersigned attorney at (1-617) 521-7014 to discuss what additional steps he believes are necessary to place the application in condition for allowance.

The fee for the Petition for Extension of time is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any charges or credits to Deposit Account No. 06-1050, order No. 02103-0581001

Respectfully submitted,
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